

REMARKS

Applicants request reconsideration and allowance of the present application in view of the following remarks.

Claims 1-34, 36, and 37 are pending in the present application. Claims 1, 36, and 37 are the independent claims.

Initially, Applicants acknowledge with appreciation the indication that claims 5, 6, 10, 11, and 12-31 recite patentable subject matter and would be allowable if rewritten in independent form to include all of the features of the base claim and any intervening claims.

Claims 1-4, 7-9, 36, and 37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,567,068 (Egashira et al. – hereinafter Egashira). Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Egashira in view of U.S. Patent No. 6,519,047 (Ahn). Claims 32-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Egashira in view of U.S. Patent No. 6,414,760 (Lopez et al.). All rejections are respectfully traversed.

Independent claim 1 recites: "...a moving body that is movable; a scan unit, moved by the moving body to scan a first paper; and a print unit, moved by the moving body to print on a second paper."

Independent claim 36 recites: "...a moving body that is movable; a scan unit, to scan a first paper; and a print unit, to print on a second paper, wherein one of the scan unit or the print unit is connected to the moving body, and the remaining one of the scan unit or the print unit is selectively connected to the moving body."

And independent claim 37 recites: "...a print unit, to print on a second paper; and a scan unit, selectively connected to the print unit, to scan a first paper, and reduce a load on the print unit during printing."

The MPEP states: "[t]o anticipate a claim, the reference must teach every element of the claim." (MPEP 2131).

The MPEP then quotes: "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Quoted in MPEP 2131).

The MPEP further quotes "[t]he elements must be arranged as required by the claim, but

this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.” *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). (Quoted in MPEP 2131).

Though in the anticipation rejection, the Office Action does not assert which elements in Egashira correspond to the claimed elements, in the Response to Arguments, the Office Action asserts that device body 41, first paper tray 31 and second paper tray 32 of Egashira correspond, respectively, to the claimed moving body, scan unit, and print unit.

Egashira discloses a combination scanner and printer housed in a device body 41. The device has first and second paper trays 31 and 32 that admit paper to first and second paper transfer paths 39 and 40. Printing unit 25 is disposed on the second paper transfer path 40, and scanner/copy processing unit 26 is disposed on the first paper transfer path 39. The device also has first and second covers 34 and 35 that provide access to the first and second paper transfer paths 39 and 40, respectively. (See Egashira, at FIGS. 1-3, and col. 3, line 61 to col. 6, line 2).

Applicants respectfully submit that Egashira neither discloses nor suggests that device body 41 moves either first paper tray 31 or second paper tray 32. Indeed, col. 4, lines 5-7 appear to indicate that moving the paper trays is a user function. Additionally, Egashira neither discloses nor suggests that first paper tray 31 scans a first paper, nor that second paper tray 32 prints on a second paper.

Thus, Egashira fails to disclose every element of the independent claims, arranged as required by the claims.

Further, regarding claim 7, which depends from independent claim 1, the Office Action improperly asserts that different elements of Egashira correspond to the claimed scan unit and print unit with respect to claim 7 than with respect to claim 1. More specifically, as noted above, with respect to claim 1, the Office Action asserts that the first paper tray 31 and second paper tray 32 correspond, respectively, to the claimed scan unit and print unit, and with respect to claim 7, the Office Action asserts that the image reader 23 and the printing section 25 correspond to the claimed scan unit and print unit.

But in an effort of compact prosecution, Applicants respectfully submit Egashira neither discloses nor suggests e.g., that image reader 23 is moved by device body 41 to scan a first paper; and printing section 25 is moved by device body 41 to print on a second paper.

Additionally, in a further effort of compact prosecution regarding claim 7, the Office Action appears to assert that since the locations of the image reader 23 and the printing section 25 can be exchanged, that they are “selectively” connected, since one is “able to make a choice

as to which unit he/she wishes to be connected to the main body.” But contrary to the Office Action’s interpretation, the portion cited by the Office Action (col. 5, lines 9-13) appears to indicate that the locations of the first and second paper transfer paths can be exchanged, for example, by a manufacturer of a device. Applicants respectfully submit that Egashira does not disclose or suggest that a user can simply choose to remove either the image reader 23 or the printing section 25 from device body 41. Applicants respectfully submit that to do so would render the device of Egashira inoperable.

And regarding claim 8, in the Response to Arguments, the Office Action directs Applicants’ attention to FIG. 3. While FIG. 3 shows that scanner/copy processing unit 26 is mounted to second cover 35 (a point that was never contested), Applicants respectfully submit that FIG. 3 does not show how scanner/copy processing unit 26 is “selectively” mounted on device body 41, since second cover 35 is still a part of device body 41 and is not shown to be removable therefrom by FIG. 3 or any other part of Egashira. Thus, Applicants respectfully submit that Egashira neither discloses nor suggests that scanner/copy processing unit 26 is removable.

Nevertheless, given the Office Action’s assertion (with respect to claim 1) that device body 41, first paper tray 31 and second paper tray 32 correspond, respectively, to the claimed moving body, scan unit, and print unit, Egashira neither discloses nor suggests that first paper tray 31 is selectively/removably mounted on device body 41.

Accordingly, Applicants respectfully submit that the Office Action has not provided sufficient evidence to maintain a prima facie anticipation rejection of at least claims 1, 7, 8, 36, and 37.

In view of the foregoing, Applicants respectfully submit that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicants believe that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. But if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously

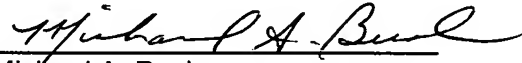
solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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